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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,773

10/01/2003

John A. Gardner

65961-0119

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7590

01/11/2005

RADER, FISHMAN & GRAUER PLLC  
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EXAMINER

RICKMAN, HOLLY C

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/676,773	<b>Applicant(s)</b> GARDNER, JOHN A.	
	<b>Examiner</b> Holly Rickman	<b>Art Unit</b> 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 54-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54-65 and 81 is/are allowed.
- 6) ☒ Claim(s) 66-80, 82 and 83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/28/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The rejection of claims 54-65 under 35 U.S.C. 112, first paragraph, is withdrawn in view of Applicant's amendments and arguments. As such claims 54-65 and newly added claim 81 are allowable over the prior art.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 66-80 and 82-83 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 5885662 in view of The Encyclopedia of Polymer Science and Technology (Encyclopedia of Polymer Science and Engineering, Volume 3, Nov. 1985, pp. 552-567).

Claim 1 of U55885662 claims: "A process for making a panel structure for mounting in an automobile vehicle to form a part of the interior thereof, the panel structure including a rigid

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substrate and a layered composite structure, the rigid substrate being hidden from the vehicle interior when the panel structure is mounted in the automobile vehicle, the layered composite structure comprising an outer layer defining at least a portion of an at least partially exposed exterior surface of the panel structure and an inner layer, said process comprising the steps of: applying a water-dispersed composition onto a first mold surface having a complementary shape to an outer surface of the outer layer, the water-dispersed composition comprising at least one light-stable aliphatic thermoplastic polyurethane containing at least one pendent functional group selected from the group consisting of hydroxyl and carboxyl functional groups, at least one coloring agent, and a heat-activated crosslinker, applying sufficient heat to induce partial crosslinking of the light-stable aliphatic thermoplastic polyurethane with the heat-activated crosslinker, substantially drying the water-dispersed composition while on the first mold surface so as to form the outer layer, spraying a rapidly reacting composition containing at least one polyisocyanate and at least one polyol onto an inner surface of the outer layer while on the first mold surface to form the inner layer which comprises a polyurethane elastomer crosslinked with the polyurethane of the outer layer via residual unreacted functional groups of the heat-activated crosslinker and thereby forming the layered composite structure having interfacial chemical bonding between the inner surface of the outer layer and an adjacent surface of the inner layer, and uniting the layered composite structure with the rigid substrate so that the rigid substrate serves to reinforce the outer layer while retaining the touch, Color, and configuration of the exposed portion.”

Further, Claim 3 of U55885662 requires the polyol of claim 1 to contain one or more of pendent hydroxy, carboxyl, or hydroxyl and carboxyl functional groups.

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Though claims 1 and 3 of U55885662 do not explicitly state that the rapidly reacting composition is a polyurethane, it is well known that the reaction of a polyisocyanate with a polyol results in the formation of a polyurethane. Further, as claim 3 of U55885662 claims that the polyol has pendant hydroxyl groups, the examiner takes the position that the polyurethane formed by reacting the polyisocyanate with this polyol is identical to the thermoplastic polyurethane having pendant hydroxyl groups required by claim 66.

However, claim 1 of U55885662 does not teach casting the thermoplastic polyurethane having pendant hydroxyl groups, as required by claim 66. However, The Encyclopedia of Polymer science teaches various well known polymer coating methods. As is clearly shown by table 1 on page 552, cast-coating is equivalent to spraying as a coating process for coating polymer(such as polyurethane) materials onto the same types of substrates. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize cast coating as opposed to spraying as the coating method for forming the rapidly reacting composition layer claimed by U55885662, as the prior art recognizes the equivalency of spraying and cast coating as suitable methods for forming polyurethane layers on the similar substrates.

The limitations of claims 67-80 are each explicitly claimed by U55885662. Specifically, claim 67 is read on by claim 2 of U55885662, claims 68-80 contain the same limitations as claims 4-17 of U55885662.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/28/04 have been fully considered but they are not persuasive.

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Applicant argues that the secondary reference relied upon in the double patenting rejection set forth above (i.e., The Encyclopedia of Polymer Science and Engineering) is not directed to casting a *coating* and thus, cannot be combined with the invention set forth in the claims of US 5885662. It is the Examiner's contention that any differences between casting of a coating and casting of any other type of layer would be obvious to one of ordinary skill in the art and any necessary process modifications would be well within the purview of one of ordinary skill in the art at the time of invention.

Applicant further argues that the different coating methods given in Table 1 of the secondary reference are not truly equivalents but rather "alternative methods." It is the Examiner's contention that the disclosed coating methods are equivalents insofar as they have the same end result. Whether they are called "equivalents" or alternative methods, they are each directed to the deposition of a layer on a surface. The Examiner maintains that the variations in process parameters between the individual method set forth in Applicant's arguments are obvious modifications and would have been well within the purview of one of ordinary skill in the art at the time of invention.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

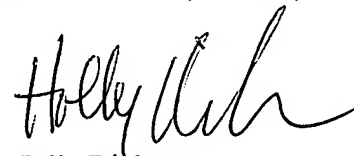
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman  
Primary Examiner  
Art Unit 1773

January 6, 2004